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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,478

09/10/2003

Carl E. Yee

BSI-260US3

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P O BOX 980

VALLEY FORGE, PA 19482-0980

EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/659,478

Applicant(s)

YEE, CARL E.

Examiner

Paul B. Prebilic

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 42-55 and 57-60 is/are pending in the application.
- 4a) Of the above claim(s) 48, 50, 51, 54, 55, 58 and 60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-47, 49, 52, 53, 57 and 59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

Claims 48, 50, 51, 54, 55, 58, and 60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 27, 2006.

***Oath/Declaration***

This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. The preliminary amendment filed the same day as the present application, September 10, 2003, added subject matter that was not referred to in the declaration. In particular, the subject matter setting forth a "non-sheath" was not supported by the parent or present specification; see MPEP 608.04(b) that is incorporated herein by reference. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 42-47, 49, 52, 53, 57, and 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. On line 8 of claim base claim 42, the term "non-sheath" is set forth. The Examiner asserts that this term does not

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have clear metes and bounds with respect to the present specification and the prior art. There is some indication in the response that a suture, adhesive, or a crochet weave is a type of second member or "non-sheath" (see page 9, fourth paragraph of the response filed July 24, 2006), however, the prior art to Strecker considers a crocheted material to be a type of sheath; see the abstract of US Patent 5,405,378. Since the Applicants have not clearly redefined the term "non-sheath" and since it contradicts the prior art, the Examiner asserts that the use thereof renders the claims indefinite. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

### ***Claim Objections***

Claims 42, 52, 53, and 57 are objected to because of the following informalities:

With regard to claim 42, the "movable member" lacks clear antecedent basis from the specification. Since it appears that the Applicants may mean that the "movable member" is the "pusher", the Examiner will understand the claim language as referring thereto.

With regard to claim 52, lines 3-4, "the expanded configuration" lacks clear antecedent basis.

With respect to claim 53, the Applicants' response seems suggest that the crochet material can be either the second member or the third member; see page 9 of the response. This is not understood since the crochet material should be one or the other since both are present within the same claim. Rather, it appears that the third member corresponds to the sheath tip. Appropriate clarification is required in response to this Office action.

With regard to claim 57, the phrase "and longitudinally slidable relative to the stent" is not understood and may be grammatically incorrect. Rather it appears that the Applicants could have meant the "and" of this phrase to be ---that is---. Appropriate clarification is required in response to this Office action.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 42, 43, 44, 47, and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Lau (US 6,001,123) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lau (US 6,001,123) in view of Lauterjung (2002/0111665) or Hartley (WO-98/53761). Lau anticipates the claim language where the prosthesis as claimed is the

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graft and stent of Lau (see Figure 11B where stent (160) underlies the graft surface of the stent and is the distal most ring thereof as seen in Figure 15A), the first member as claimed is the catheter of Lau, the second member as claimed is loop(s) (308), and the movable member as claimed is the tether wire (306).

Alternatively, one may not consider Lau as disclosing the stent underlying the graft and not on the end as claimed. However, both Lauterjung [see the figures] and Hartley et al (WO) [see particularly Figure 13C] teach that it was known to put stents under the graft and not on one end of the graft. Therefore, it is the Examiner's position that it would have been at least obvious to put the stent more under the graft and leaving one end free in Lau for the same reasons that the secondary references do the same or to allow insertion of a second stent graft on the stentless end.

With regard to claim 57, the underlying configuration is read on Figure 15B up side down.

### ***Allowable Subject Matter***

Claims 45, 49, 52, 53, and 59 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending

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claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic  
Primary Examiner  
Art Unit 3738